UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,529	11/15/2001	Yasuhiro Hino	35.C15947	7272

5514   7590   01/25/2008
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER
NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
01/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *RCE filed on October 31, 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11,13,17-26 and 28* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9, 11, 13, 17-26, 28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.

Response to Arguments

2.   Applicant's arguments filed on October 31, 2007 have been fully considered but they are

not persuasive.

  a.   Applicant remarks that, in Nehab et al., the disk 5 does not output any image on a

  recording medium. Thus, if web printer 17 were to correspond to the external apparatus,

  disk 5 would not acquire data for output from the web printer 17.

It is noted that Nehab et al discloses a personal news retrieval system 1 (Figs.1-2) with a

printer interface 10 connected to a printer 7. The system 1 comprises a sending unit (CPU 8) for

sending the acquisition information (URI) and layout information received by the command and

information input from a user and send them to the Web Printer 17 in disk 5, an acquisition unit

(printer interface 10 (Fig.2) or output interface 40 (Fig.6)) for acquiring the printed data

generated by the external apparatus 5. Disk 5 is the external apparatus since it generates the data

for output based on the acquisition sent by the sending unit and the layout information sent by

the sending unit. For instance, Nehab et al teaches, "… a user can specify the URL address of a

document to be formatted and the format of that document…" (col. 14, lines 6-17). From Fig.6,

the Web Printer 17 is responsible for retrieving news articles: Web reader 34 sends the retrieved

data to Web printer 17, Web printer extracts the data and formats the data for output via output

interface 40 for printing by printer 7. Nehab et al teaches, "Formatter 42 is responsible for

flattening the extracted data tree into a linear document and formatting the linear document into a

personalized newspaper. Formatter 42 performs these functions in accordance with the print

criteria and format information … indicated in personal-new-profile 19." (col. 11, lines 29-35),

and "Print 81, …, when activated, cause Web-Formatter to download all data at Web pages

defined by the URLs …, format them as specified by the user, create RTF files(s) … and do the

selected action, i.e., save, edit or print the RTF files(s)." (col. 16, lines 21-26). Nehab et al

further teaches, "Print icon 96 opens a print dialog box (not shown), which allows a user to print

any number of copies of Web pages formatted by Web-Formatter." (col. 16, lines 55-57). Thus,

the disk 5 acquires data for outputting them to the printer 7 of the system 1 for printing, and

printer 7 is the recording medium as claimed in the claims.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

>   (a) A patent may not be obtained though the invention is not identically disclosed or
>   described as set forth in section 102 of this title, if the differences between the subject
>   matter sought to be patented and the prior art are such that the subject matter as a whole

would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-9, 11, 13, 17-26, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab (US Patent No. 6,0209,182) in view of Vidyanand (Publication No. US 2006/0023246).

Concerning claim 1, Nehab discloses an image forming apparatus 1 (Figs.1-2) capable of outputting an image based on data for output generated by an external apparatus (5) on a recording medium (7) comprising a sending unit (8 or 12 or 13, Fig.2), adapted to send, from the image forming apparatus to the external apparatus (5), acquisition information for acquiring data and layout information necessary for assigning an image based on the data to the recording medium (7) so as to cause the external apparatus (5) to acquire the data in accordance with the sent acquisition information and generate data for output, wherein the image based on the data for output can be accommodated based on the acquired data and the sent layout information; and an acquisition unit (10, Fig.2 or 40, Fig.6) adapted to acquire the data for output generated by the external apparatus; wherein the external apparatus (5) generates the data for output based on the acquisition information sent by the sending unit and the layout information sent by the sending unit (Figs.5, 7-9; Abstract; col. 5, line 34 – col. 6, line 17; col. 7, line 23 – col. 8, line 60; col. 9, line 46 – col. 11, line 35; col. 12, lines 40-63; col. 14, lines 6-58; col. 16, lines 22-57; col. 17, lines 15-18; col. 18, lines 54-59).

It is noted that the disk 5 can be considered as an external apparatus since it is removable from the apparatus 1 and it is connected to web reader 34 for retrieving data file from the web.

Nehab fails to directly teach that the layout information including information on the recording medium having predetermined size and the image based on the data for output can be accommodated in the predetermined size based on the acquired data and the sent layout information. Vidyanand discloses an apparatus and method for transferring printer driver preferences across a network between client computers (Figs.1-4) wherein the user can selectively modify the set of preferences. For instance, the user selects from a varied list of selectable options within a printer driver preferences menu wherein selected file specific options can be selected paper size (e.g., letter, legal, A4) (paragraph 0003). In addition, Fig.5 shows a set 16 of selected printer driver preference values based upon printer driver categories 47a-47n wherein 47a is for selecting page size (paragraph 0038). The paper size selection can be selected within the user interface 50 (paragraph 0043) since the user can create a plurality of sets of preferences 18 typically for different types of print jobs 21 or modify the selected page size from within the printer driver control interface 50 (paragraph 0045). Vidyanand further teaches a page layout thumbnail preview 94 providing a graphic representation of the current page layout, as a print job would be printed to an output device 26, for instance, the graphic representation in Fig.9 currently shows a portrait orientation setting 18c on letter size paper setting 18a of the page size 47a (paragraph 0049). Thus, the page layout in Vidyanand includes the predetermined size of the paper (recording medium). It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of the layout information including information on the recording medium having the predetermined size in Vidyanand to the page layout information in Nehab since both Vidyanand and Nehab teach transmitting and receiving printer driver preferences or page layout information in a client/server architecture while Nehab et al

specifically teaches details of the layout format that are based on the system's printer capabilities (col. 10, lines 7-13).

Concerning claims 2-5, 8-9, 18, 21, 24, 25, Nehab in view of Vidyanand further teaches the acquisition information for acquiring the data is information for identifying the data (claims 2, 18); the information for identifying the data is represented by URI (claim 3); a reception unit adapted to receive print instruction including the acquisition information indicating the position of storage of data and the layout information, wherein the sending unit sends to the external apparatus the acquisition information and the layout information included in the print instruction received by the reception unit (claim 4); the acquisition unit acquires the data for output through a network (claims 5, 21); the structured description language is XML or HTML (claims 8, 24); the apparatus is a printing apparatus (claims 9, 25), (col. 7, line 23 – col. 8, line 60; col. 9, line 46 – col. 10, line 44; col. 12, lines 40-63; col. 14, lines 6-58; col. 17, lines 15-18; col. 18, lines 54-59).

Concerning claims 6-7, 13, 22, 23, 28, Vidyanand further teaches that the information on the recording medium is information indicating a sheet size or a layout direction; and the layout information is information designating a page and the acquisition unit acquires the data for output corresponding to the designated page (paragraphs 0038, 0043, 0045, 0049).

Concerning claim 11, Nehab in view of Vidyanand discloses an image forming system as disclosed in claim 1 above. Nehab further teaches a changing unit adapted to change the layout information received by the reception unit to layout information assigning an image (col. 7, lines 38-67; col. 9, lines 47-54; col. 18, lines 54-59).

Claim 17 is method claim of apparatus claim 1. Claim 17 is rejected for the same

rationales set forth for claim 1.

Concerning claims 19-20, Nehab in view of Vidyanand further teaches the information

for identifying the data is represented by URI (URL), (claim 19), receiving a print instruction

and sending to the external apparatus the acquisition information and the layout information

included in the print instruction (claim 20), (col. 14, lines 6-35; col. 19, line 45-52).

Claim 26 is method claim of apparatus claim 11. Claim 26 is rejected for the same

rationales set forth for claim 11.

Conclusion

3.   Claims 1-9, 11, 13, 17-26, 28 are rejected.

4.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-

7466. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward L. Coles can be reached on 571 272-7402. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Madeleine AV Nguyen
Primary Examiner
Art Unit 2625

January 22, 2008